



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/004,511
Applicant : Shannon Morris
Filed : October 22, 2001
TC/A.U. : 3728
Examiner : Luan Kim Bui

Docket No. : OSSV-083441
Customer No. : 30764

REQUEST FOR INTERVIEW FOR
RECONSIDERATION OF FINAL REJECTION

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

FEB 2 4 2004

OFFICE OF PETITIONS

Sir:

In accordance with MPEP § 713, Applicant hereby requests an interview by telephone with the Examiner in charge of this application. There follows a brief explanation of the intended purpose and content of the interview.

The purpose of the interview is to seek reconsideration of the final rejection of claims 8-11 and to try to avoid the necessity of an appeal. More specifically, Applicant wishes to gain a better understanding of the Examiner's interpretation of both the claims and scope and content of the cited prior art. Applicant is utterly at a loss to understand how the Examiner is interpreting the claims and the prior art in support of his rejections.

The Examiner has finally rejected claims 8-11 as allegedly anticipated by U.S. Patent No. 5,040,681 to Grusin, again asserting that "[t]he knob of Grusin is inherently capable of receiving at least one finger ring over the knob (FIGS. 1-5)." Office Action, page 2. The Examiner similarly has finally rejected claims 8-11 as allegedly anticipated by or obvious over U.S. Patent No. 2,036,572 to Frost, again asserting that "[t]he knob of Frost is inherently capable

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of receiving at least one finger ring over the knob ..." Id., page 3. The Examiner also has asserted again that "Frost discloses ... a knob (4) protruding upwardly from the body and extending above the upper surface of the body ..." Id.

It is fundamental that a claim is anticipated only when the same device, having all of the elements and limitations contained in the claims, is described in a single prior art reference. ATD Corp. v. Lydall, Inc., 159 F.3d 534 (Fed. Cir. 1998) (citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989)). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. Id. (citations omitted).

A reference that does not expressly disclose one or more claimed features can be anticipatory only if the features are inherent in the reference. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991). However, evidence of inherency "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Id. at 1268 (emphasis added).

An invention is not inherent simply because the obtained result possibly could occur. Rather, an inherent invention is embodied in a single prior art that dictates the result. See Hansgirg v. Kemmer, 102 F.2d 212, 214 (C.C.P.A. 1939) ("Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."); Continental Can, 948 F.2d at 1269; In re Oelrich, 666 F.2d 578, 581 (C.C.P.A. 1981). "Inherency does not mean that a thing might be done, or that it might happen, ... but it must be disclosed, if inherency is claimed, that the thing will necessarily happen." In re Draeger, 150 F.2d 572, 574 (C.C.P.A. 1945) (citations omitted, emphasis added); see also Giambalvo v. Detrick, 168 F.2d 116, 120 (C.C.P.A. 1948).

It is indisputable that knob 30 formed on cover 18 of Grusin's desk organizer is not inherently capable of receiving a ring finger because it is not necessarily sized to receive a finger ring. As explained in the Amendment dated April 29, 2003, this is a matter of simple geometry. To put it in visual terms, Applicant attaches as Exhibit A copies of the drawing pages

from Grusin that contain FIGS. 2 and 5. In Exhibit A, Applicant has drawn a hypothetical ring received over knob 30. Clearly the ring is far too oversized to be a finger ring.

Even more, Grusin teaches away from sizing his knob 30 to receive a finger ring because "the knob 30 is provided with an aperture 54 positioned immediately above the aperture 52 of the third post member 46. ... [and] ... aperture ... 54 is so dimensioned as to conveniently permit the insertion of a finger through the center of the knob 30 ..." (Col. 3, lines 44-55.) Grusin goes on to describe that "aperture ... 54 defines a ... lip ... 62 which can be grasped by the user's finger tip ..." (Id., lines 55-58.) Therefore, as shown in FIG. 5, for the knob 30 to have an aperture 54 large enough to receive the person's finger and enough surrounding material to form a lip 62 for the person's finger to grasp, the outside dimensions of the knob necessarily are much larger than a person's finger.

Likewise, there is no basis whatsoever for the Examiner's assertion that so-called "knob" 4 of Frost is inherently capable of receiving a ring finger. What the Examiner refers to as a knob in Frost is actually "a small round central embossing". (Col. 3, lines 1-2.) The only purpose of this central embossing is to support a pie crust. Since there is no suggestion in Frost of using central embossing 4 to hold a finger ring, there is no basis for asserting that the embossing necessarily is sized to receive a finger ring.

The Examiner's comment that "the ring is not positively claim [sic] with the organizer" (Office Action, page 4) is misplaced. Applicant's invention is not the combination of a jewelry organizer and a ring; it is a jewelry organizer sized and configured for rings and other types of jewelry. The reference to a finger ring is a size reference. Finger rings come in various sizes. Yet, any person of ordinary skill in the design of jewelry organizers will readily understand the size ranges of finger rings without making the rings a positive limitation of the claims.

The Examiner's concern is readily answered by the case of Orthokinetics, Inc. v. Safety Travel Chairs, 806 F.2d 1565 (Fed. Cir. 1986). In that case, claim 1 defined a pediatric wheelchair and contained the limitation "wherein said front leg portion is so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats

thereof." Id. at 1575. Clearly the automobile was not positively claimed with the wheelchair. The Federal Circuit held as follows:

The claims were intended to cover the use of the invention with various types of automobiles. That a particular chair on which the claims read may fit within some automobiles and not others is of no moment. The phrase "so dimensioned" is as accurate as the subject matter permits, automobiles being of various sizes. As long as those of ordinary skill in the art realized that the dimensions could be easily obtained, § 112, 2d ¶ requires nothing more. The patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.

Id. at 1576. The same is true here. Applicant is allowed to refer in the claim to other objects with which the invention is designed to be used, and need not be specific about the dimensions of the other objects so long as "those of ordinary skill in the art realized that the dimensions could be easily obtained".

Finally, Applicant is at a loss to understand the Examiner's characterization of the central embossing 4 of Frost as "protruding upwardly from the body and extending above the upper surface of the body ." A copy of the face page of Frost showing an enlargement of FIG. 2 is attached as Exhibit B. On Exhibit B, Applicant has indicated her understanding of the only way in which the Examiner could interpret Frost in relation to Applicant's claims. As can be seen, the "upper surface" of the body would correspond to the upper surfaces of raised embossings 5, 8 and 12 that surround the so-called "knob," central embossing 4. This must be the upper surface that the Examiner is referring to in Frost because claims 8-11 also require "at least one compartment formed in the upper surface". The "upper surface" cannot be the bottom surface of the unembossed annular portions 10, 11, 14 or 15 or the lateral spaces 7 because they do not have any compartments formed in them; indeed, according to the Examiner, unembossed annular portions 10, 11, 14 and 15 are the compartments.

It is indisputable that the central embossing 4 is exactly the same height as the other embossings 5, 8 and 12. Therefore, Frost also does not satisfy the claim requirement of "a knob protruding upwardly from the body and extending above the upper surface." Moreover, it would be odds with the purposes of Frost's pie plate to make the central embossing 4 higher than the other embossings 5, 8 and 12, since this would render the pie plate dysfunctional.

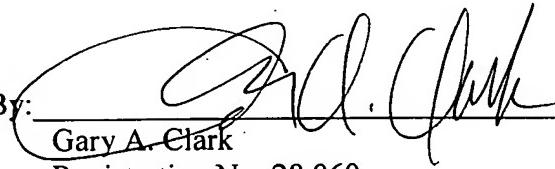
Accordingly, there is no basis for rejecting claims 8-11 as allegedly anticipated by Grusin, or as anticipated by or obvious over Frost.

Finally, Applicant does not seek to address in the interview the Examiner's decision that claims 16-20 do not read on the elected embodiment. Applicant finds the Examiner's restriction requirement to be inexplicable, but at least claim 8 is generic to the embodiment of Applicant's invention having an elongated, spiral channel because such a channel corresponds to "at least one compartment" as recited in claim 8. Therefore, the allowance of claim 8 will give Applicant a measure of protection for the spiral channel version of her invention.

Applicant requests a telephone call from the Examiner to arrange a telephone interview to discuss the above matters.

Date: October 29, 2003

Respectfully Submitted,
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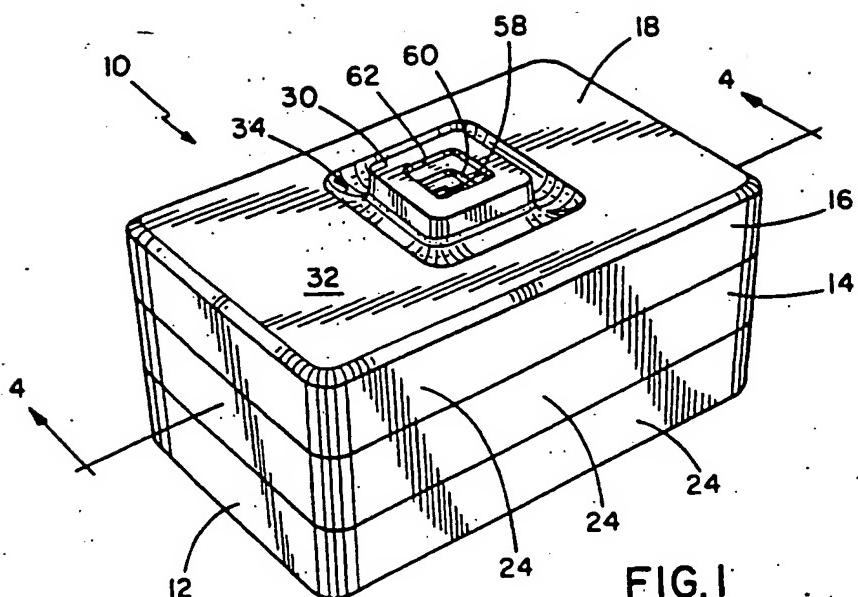


FIG. 1

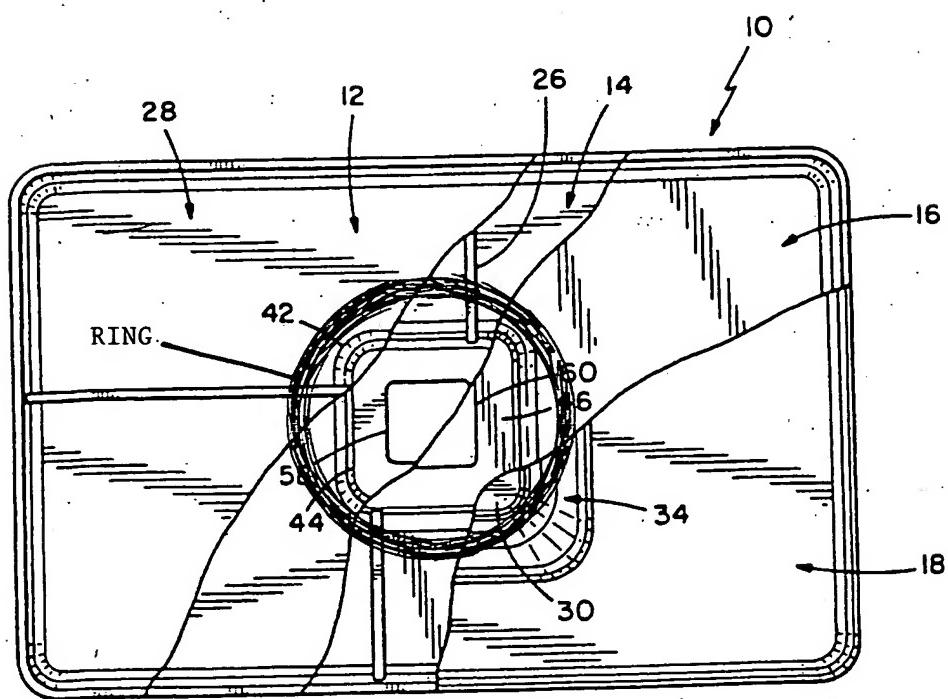


FIG. 2

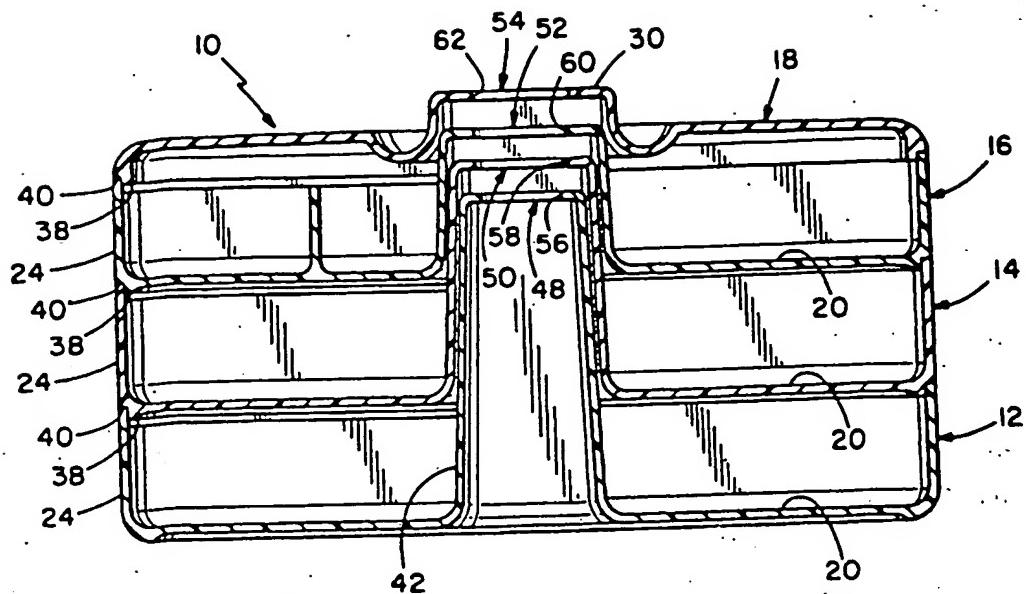


FIG. 4

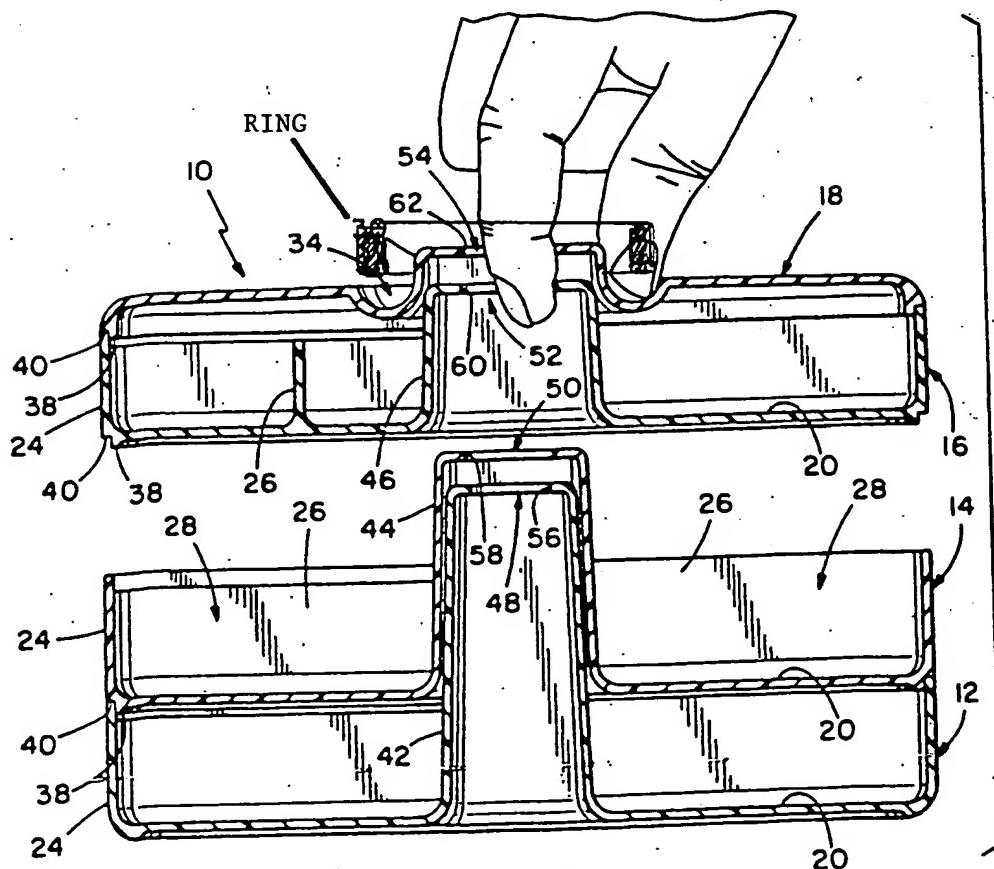


FIG. 5

